



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/553,679

10/17/2005

Peter Tass

23384

1840

535 7590 07/16/2007
K.F. ROSS P.C.
5683 RIVERDALE AVENUE
SUITE 203 BOX 900
BRONX, NY 10471-0900

EXAMINER

SMITH, TERRI L

ART UNIT

PAPER NUMBER

3762

MAIL DATE

DELIVERY MODE

07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,679

Applicant(s)

TASS, PETER

Examiner

Terri L. Smith

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10-17-05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 19 in line 22, the phrase “that mean that” is confusing.

On page 20 in line 13, it appears that the word “bout” should be a different word.

Similarly, on page 21 it appears that the word “primary” (line 4) and “approaches” (line 8) should be different words. As written the statements are not clear.

On page 24 in lines 15–17, the sentence “This can be ...for the stimulation” is confusing. Perhaps the word “means” should be a different word.

On page 52 in line 16, “rythme” appears to be a typographical error.

Appropriate correction is required.

Claim Objections

2. Claims 6–50 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. See MPEP § 608.01(n). Accordingly, the claims ⁶~~8~~–50 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the Applicant regards as his invention.

4. Claims 1–5, 51 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In claim 1, the phrase “characterized in that it comprises” is

Art Unit: 3762

vague and indefinite. It is unclear what the word "it" is referring to. Additionally, after establishing what the word "it" refers to, it is suggested to use the phrase "further comprising:" instead.

In claim 2, the phrase "characterized in that" is vague and indefinite. It is suggested to use the phrase "further comprising:" instead. Additionally, the phrase "the control" is vague and indefinite. It is suggested to use the phrase "the control means" instead.

In claim 3, the phrase "characterized in that it comprises" is vague and indefinite. It is unclear what the word "it" is referring to. Additionally, after establishing what the word "it" refers to, it is suggested to use the phrase "further comprising:" instead. Additionally, the phrase "a control" is confusing. It is unclear which control is being referred to. Is this the same as the control means or the control in claims 1 and 2? Further, the phrase "at least two electrodes" is confusing. Are these the same electrodes used in claimed 1?

In claim 4, the phrase "characterized in that" is vague and indefinite. It is suggested to use the phrase "further comprising:" instead. Additionally, the phrase "the control" is vague and indefinite. It is suggested to use the phrase "the control means" instead. Further, the phrase "the group of" is an improper Markush claim. A proper Markush claim should read: "selected from the group consisting of."

In claim 5, the phrase "characterized in that" is vague and indefinite. It is suggested to use the phrase "further comprising:" instead. Additionally, the phrase "the control" is vague and indefinite. It is suggested to use the phrase "the control means" instead.

Art Unit: 3762

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1–5, 51 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward et al., U.S. Patent 5,978,702.

7. Regarding claims 1–3, 51 and 52, Ward et al. disclose N electrodes (2) and control means (e.g., Figs. 1, 2, 5, 6 and, elements 16-implanted device, 130-sensor/electrode, N1–N3-neurons, 38 and 40-stimulation electrodes; column 3, lines 25–27 and 32–40; column 4, lines 59–67; column 9 TABLE IV). [NOTE: It is the Examiner's position that because Ward et al. discloses the N electrodes and control means as claimed, Ward et al. also meet the claimed limitation of subpopulations because Applicant's specification states: "If N stimulation locations are

Art Unit: 3762

stimulated the entire nerve cell population to be desynchronized is subdivided into substantially N equidistant subpopulations" (See page 19, lines 19–22).]

8. With respect to claims 4–5, Ward et al. disclose an individual stimulus is at least a component from high and low frequency pulse trains (e.g., Figs. 7A–7C-stimulation pulses; column 9, lines 23–26, 28–29, 36–42 and 47–53; columns 9 and 10, TABLE IV).

9. Claims 1–5, 51 and 52 rejected under 35 U.S.C. 102(e) as being anticipated by Pless, U.S. Patent 7,174,213.

10. Regarding claims 1–3, 51 and 52, Pless discloses N electrodes (2) and control means (e.g., FIG. 12; FIGS. 13 and 22, element 314; column 2, lines 34–38; column 3, lines 1–20 and 51–65; column 4, lines 3–4; column 7, lines 4–26; column 18, lines 46–58). [See NOTE above in paragraph 7.]

11. With respect to claims 4–5, Pless discloses high and low frequency pulse trains, biphasic individual pulses (e.g., FIGS. 1, 3–11; column 7, lines 27–29, 33–34, 38–39; column 8, lines 42–43; column 10, lines 27–28 and 59–61; column 11, lines 51–53 and 55–57; column 15, lines 37–39).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Terri L. Smith whose telephone number is (571) 272-7146. The Examiner can normally be reached on 7:30 a.m. - 4:30 p.m..

Art Unit: 3762


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



TLS
July 9, 2007

9 July 2007



GEORGE R. EVANISKO
PRIMARY EXAMINER

7/9/7